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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/058,785 | 01/30/2002 | Philip Ted Kortum | P21782 | 4132 |

7055 7590 01/04/2006

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EXAMINER

CHOW, MING

| | |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

2645

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|---------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/058,785 | KORTUM ET AL. | |
| | Examiner | Art Unit | |
| | Ming Chow | 2645 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 16-19, 22-34, 37 and 38 is/are rejected.
- 7) ☒ Claim(s) 14, 15, 20, 21, 35 and 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10-7-05, 10-24-05</u> | 6) <input type="checkbox"/> Other: _____ |

Allowable Subject Matter

1. Claims 14, 15, 20, 21, 35, 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not teach transferring the call from a position of the IVR menu to a service representative and further transfer back to the position of the IVR menu. Also, the prior art does not teach transferring the call from a position of the IVR menu to a service representative and further transfer back to a menu option other than the position of the IVR menu.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 5-13, 16-19, 22, 23, 26-34, 37, 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burg et al (US: 6456699).

Regarding claims 1, 19, 22, Burg et al teach on Fig. 6, item 200 Fig. 7, receiving a call to the IVR system.

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Burg teaches on Fig. 2, presenting a main menu with a plurality of messages.

Burg failed to teach “each menu message representing a procedure”. However, the content of each message in the menu is a “Design Choice”. For example, an IVR menu can be designed as follow. The exemplary menu has three menu options. Each menu option has one or multiple sub-menu message.

Menu option 1: New Customer Registration

Sub-menu message 1-1: Credentials are required. Please get your driver license ready.

Sub-menu message 1-2: Please get your credit card ready. Driver license and credit card are the only credentials required for registration.

Sub-menu message 1-3: Have you had the driver license and credit card ready?

Sub-menu message 1-4: You have been registered and your driver license is xxxxxx and your credit card number is 12345678. Is this correct?

Menu option 2: Placing Orders

Sub-menu message 2-1: Please get your credit card number ready.

Sub-menu message 2-2: Please get your shipping address ready.

Menu option 3: Order status Inquiry

Sub-menu message 3-1: Please get your order number ready.

Sub-menu message 3-2: Please get your shipping address ready.

The menu options correspond to the menu options 26-30 Fig. 2 of Burg et al. The “New Customer Registration”, “Placing Orders”, and “Order status Inquiry” are the claimed “menu message representing a procedure”.

It would have been obvious to one skilled at the time the invention was made to modify the menu items as taught by Burg et al to have the “each menu message representing a procedure” as an alternate “Design Choice” such that the modified system of Burg et al would be able to support the system users conveniences of providing procedures through the IVR menus.

Burg et al teach on column 7 line 30, IVR prompts (claimed “prompting the caller to select”).

Burg et al teach on Fig. 2, presenting a sequence of sub-menus to the caller according to a selection by the caller. For example, the caller selects item 26 Fig. 2, the a sequence of sub-menus (item 31 and its next level sub-menus) are presented.

Burg et al failed to teach the “sequence of sub-menus are instructions to the caller and each instruction identifying a task to be performed by the caller that is distinct from interaction with the IVR system”. However, the contents of the sub-menus as taught by Burg et al is a “Design Choice”. By using the exemplary menus, the “Sub-menu message 1-1: Please get your driver license ready” and “Sub-menu message 1-2: Please get your driver license ready” are the claimed “a sequence of instructions to the caller”. The “Please get your driver license ready” is a task to be performed by the caller and the task is distinct from interaction with the IVR (no interaction with the IVR for getting the driver license ready).

It would have been obvious to one skilled at the time the invention was made to modify the sub-menus contents as taught by Burg et al to have the “sequence of sub-menus are

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instructions to the caller and each instruction identifying a task to be performed by the caller that is distinct from interaction with the IVR system” as an alternate “Design Choice” such that the modified system of Burg et al would be able to support the system users conveniences of providing caller task instructions and the tasks are performed by the caller without interacting with the IVR.

Burg et al teach on column 12 line 64-65, IVR system pauses at the termination point and waits for the user to provide additional instructions. Burg et al teach on column 3 line 43-44, waiting for a response within a specified time.

Burg et al teach on Fig. 7, “COULD YOU REPEAT THAT” to confirm the caller’s selection. Burg et al failed to teach this message is to query the caller whether the caller has performed the task. However, the content of the confirmation step is a “Design Choice”.

It would have been obvious to one skilled at the time the invention was made to modify the content of confirmation step as taught by Burg et al to have the “Have you had your driver license ready?” as an alternate “Design Choice” such that the modified system of Burg et al would be able to support the system users conveniences of confirming with the caller to ensure the instructed tasks have been performed.

Regarding claims 2, 23, Burg et al teach on Fig. 7, “I’m sorry, could you repeat that” and “3rd attempt yes/no?” and back to step 203 of Fig. 7.

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Regarding claims 5, 26, see exemplary menus as stated in claim 1 above. The “Credentials are required.” of Sub-menu message 1-1 is the claimed “presenting a summary of the instructions”. This summary is presented after the caller selects menu option 1.

Regarding claims 6, 7, 27, 28, see exemplary menus as stated in claim 1 above. The “Driver license and credit card are the only credentials required for registration” is the claimed “presenting summary of instructions after the sequence of instructions has been presented”. This summary is also immediately presented after the caller’s selection. Any time period is considered as “immediately” unless Applicant’s current specification defines the time period for the limitation of “immediately”.

Regarding claims 8, 11, 29, 32, rejections as stated in claim 2 above apply.

Burg et al failed to teach the re-presented instruction is “a previously presented instruction”. However, the content of re-presented instruction is a “Design Choice”.

It would have been obvious to one skilled at the time the invention was made to modify the content of re-presented instruction as taught by Burg et al to have the “previously presented instruction” as an alternate “Design Choice” such that the modified system of Burg et al would be able to support the system users conveniences of re-present the previous presented instructions.

Regarding claims 9, 13, 16, 17, 30, 34, 37, 38, Burg et al teach on column 10 line 42-58, the user can return (reads on claimed “a request by the caller”) to the previous menu. By

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referencing the exemplary menus, the caller returns to “Menu option 1”. The message “New Customer Registration” is the claimed “additional information” which is followed by recommencing the sequence of instructions “Sub-menu message 1-1” and “Sub-menu message 1-2”.

Regarding claims 10, 31, Burg et al failed to teach “querying the caller after the caller has performed a task”. However, the content of instruction is a “Design Choice”. See “Sub-menu message 1-3” of the exemplary menus.

Regarding claims 12, 33, Burg et al failed to teach “querying the caller as to whether the procedure was performed correctly”. However, the content of sub-menu message is a “Design Choice”. See Sub-menu message 1-4 of the exemplary menus.

Regarding claim 18, Burg et al teach caller selection at item 11 Fig. 1. In response to the caller’s selection, sub-menus are presented (for example, ACCESSORIES).

Burg et al failed to teach the “ACCESSORIES” is “troubleshooting information”. However, the content of a message a “Design Choice”.

It would have been obvious to one skilled at the time the invention was made to modify the content of sub-menu as taught by Burg et al to have the “troubleshooting information” as an alternate “Design Choice” such that the modified system of Burg et al would be able to support the system users conveniences of troubleshooting.

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3. Claims 3, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burg et al as stated in claim 2 above, and in view of Burg et al, O'Sullivan (US: 5493608).

Burg et al failed to teach "transferring the.....of times". However, O'Sullivan teaches on column 1 line 66 to column 2 line 2, the IVR forwards the caller to an operator if the caller does not respond within the response time (reads on claimed "after instruction has been re-presented to the caller").

It would have been obvious to one skilled at the time the invention was made to modify Burg et al to have the "transferring the.....of times" as taught by O'Sullivan such that the modified system of Burg et al would be able to support the transferring caller to an operator to the system users.

4. Claims 4, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burg et al as stated in claim 1 above, and in view of Dewan (US: 6654447).

Burg et al failed to teach "pausing the instructions in response to a command by the caller". However, Dewan teaches on column 2 line 14-16, a caller may pause the message played by the IVR.

It would have been obvious to one skilled at the time the invention was made to modify Burg et al to have the "pausing the instructions in response to a command by the caller" as taught by Dewan such that the modified system of Burg et al would be able to support the system users conveniences of pausing the instructions.

Response to Arguments

5. Applicant's arguments filed on 10/7/05 have been fully considered.
 - i) Applicant argues, on page 10, the cited prior art (US: 6539080) was owned by the Applicant at the time the invention was made. Therefore, new grounds of rejections are applied as stated in this Office Action which is non-final.

Conclusion

6. The prior art made of record and not replied upon is considered pertinent to applicant's disclosure.

- US: 5884262

7. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (571) 272-7535. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner

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by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (571) 272-2600. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

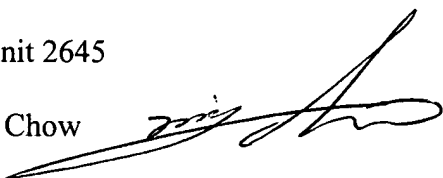
Washington, D.C. 20231

Or faxed to Central FAX Number 703-872-9306.

Patent Examiner

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Ming Chow

A handwritten signature in black ink, appearing to read 'Ming Chow', is written over the printed name.